


all the recited claim limitations. See MPEP §2143. For reasons that will be discussed below in detail, it is respectfully submitted that, with regard to the pending claims, the Examiner has supported no *prima facie* case of obviousness.

It is respectfully submitted that the cited references fail to teach or suggest all the recited claim limitations. Independent claims 1, 13 and 23 recite receiving and placing orientation data and multiple-switch data in a data packet. Independent claim 16 recites a data structure containing physical orientation data and multiple-switch information. Independent claim 20 recites a computer input device that enables the creation of data packets that include physical orientation data and multiple-switch information. It is respectfully pointed out that all of the claims pending in the present case recite some variation of a data packet that includes physical orientation data and multiple-switch information related to a device having at least two degrees of motional freedom.

16 It is respectfully submitted that even if the Hall and Willner references are combined, the combination does not teach or suggest the data packets specifically recited in Applicant's claims. The Hall reference essentially teaches a data packet that corresponds to a computer mouse and does not include any information pertaining to multiple-switch information related to a device having at least two degrees of motional freedom. The Willner reference does not teach formation of any data packet, but does teach a control device having multi-directional switch assemblies. Neither Hall nor Willner teach or suggest the formation of a single data packet that contains both multiple-switch information related to a device having at least two degrees of motional freedom and physical orientation data. Therefore, the cited references fail to teach or suggest limitations specifically recited in all of Applicant's pending
33 claims.

A handwritten bracket on the right side of the page, spanning from the paragraph starting with "16 It is respectfully submitted..." down to the paragraph starting with "33 claims.". To the right of the bracket, there is a circled number "1".

Further, it is respectfully submitted that the Examiner has not provided a sufficient suggestion or motivation to combine the Hall and Willner references. It is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section. In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). The factual inquiry whether to combine references must be thorough and searching. Id. It must be based on objective evidence of record. In re Sang Su Lee, Case No. 00-1158, *7 (Fed. Cir., January 18, 2002) (Fed. Cir. BBS). It is respectfully submitted that, in the present case, the only conclusion that can be reached from the alleged combination of the references is the impermissible hindsight gleaned from the present invention. See, e.g., Ex parte Haymond, 41 USPQ2d 1217, 1220 (BdPatApp&Int 1996) (the Examiner "may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis.")

hindsight not used
Hall discloses more
than asserted in
embodiment
but does not
show them

Simply stated, the Office Action does not provide any objective evidence that shows a motivation to combine the Hall and Willner references. Without such objective evidence, no *prima facie* case of obviousness has been made against the pending claims.

Still further, it is respectfully submitted that the proposed combination of the Hall and Willner references is suspect because the modifications necessary for the combination would cause the art to become inoperable or destroy its intended function. Specifically, combining the references would destroy the intended function of Hall. The right and left push buttons taught by Hall are used for the selection of program items (e.g., for altering the program flow in a host computer). In accordance with Hall, the relative displacement of the mouse is determined through either mechanical or optical methods separate from the left and right push buttons. It is respectfully submitted that

not true
Hall discloses
an embodiment
saying 2 or
more switches

if the multi-directional switches of Willner were incorporated into the left and right push buttons of Hall, Hall's function of altering program flow would be lost and replaced with an additional orientation ability. Hall already possesses an orientation ability and has no disclosed or suggested use for an additional orientation ability.

For all of the above-discussed reasons, it is respectfully submitted that, with regard to the pending claims, the Examiner has supported no *prima facie* case of obviousness. Accordingly, Applicant respectfully submits that the pending claims are allowable in their present form. Applicant respectfully solicits allowance of the pending claims, namely, claims 1-20, 22 and 23.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

WESTMAN, CHAMPLIN & KELLY, P.A.

By: 

Joseph R. Kelly, Reg. No. 34,847
Suite 1600 - International Centre
900 Second Avenue South
Minneapolis, Minnesota 55402-3319
Phone: (612) 334-3222 Fax: (612) 334-3312

JRK/LRT/jme